

REMARKS

With this Amendment A, claims 1-5, 8-13, 17-20, 23-32, 35-39, and 42-43, as amended, are currently pending in this application. Claims 6-7, 14-16, 21-22, 33-34, and 40-41 have been canceled. New dependent claims 42-43 have been added.

The Examiner rejected original claims 1, 7, 8, 13-16, 22-23, 25, 28, 34-35, 37 and 41 as previously presented under 35 U.S.C. 102(e) as being anticipated by Griffin et al. ("Griffin"), US 6,489,950 B1. As noted above, claims 7, 16, 22, 34 and 41 have been canceled. Independent claims 1, 13, 28 and 35 have each been amended to include:

receiving input requesting a first list of alternate symbols associated with a
first base symbol; and

displaying simultaneously a plurality of alternate symbols from the first
list in a pop-up menu at an insertion location for displaying at least one
of the alternate symbols on a display of the hand-held device.

Based on these claim amendments, the Examiner's rejection under 35 U.S.C. 102(e) as being anticipated by Griffin et al. ("Griffin"), US 6,489,950 B1 has been overcome. In view of these amendments, Applicant addresses the Examiner's points made in his rejection of now canceled claims 6, 21, 33, and 40 under 35 U.S.C. 103(a) as being unpatentable over Griffin in view of Davis et al., ("Davis"), US 5,485,373 with respect to claims 1, 8, 13, 23, 25, 28, 35, and 37 as currently amended. Each of canceled claims 6, 21, 33 and 40 included the specific recitation of "displaying a pop-up menu of one or more alternate symbols in the first list

associated with the first base symbol.” The Examiner acknowledged Griffin does not teach this limitation. The Examiner asserts Davis as a basis for teaching this specific recitation in combination with Griffin. The Examiner further asserts that one of ordinary skill in the art would have known that choice of alternate symbols in the device of Griffin could have been presented in a form of pop-up menu taught by Davis, because of the advantage that the pop-up menu would show choices at a glance and will allow a user to scroll in right direction rather than go through all sequence by scrolling and displaying alternate symbols one at a time, as taught by Griffin.

For independent claim 1 as amended, the combination of Griffin in view of Davis fails to disclose, teach or suggest at least the limitation of “displaying simultaneously a plurality of alternate symbols from the first list in a pop-up menu at an insertion location for displaying at least one of the alternate symbols on a display of the hand-held device.” For independent claim 13 as amended, the combination of Griffin in view of Davis fails to disclose, teach or suggest at least the limitation of software comprising instructions for performing “displaying simultaneously a plurality of alternate symbols from the first list in a pop-up menu at an insertion location for displaying at least one of the alternate symbols on a display of the hand-held device.” For independent claim 28 as amended, the combination of Griffin in view of Davis fails to disclose, teach or suggest at least the limitation of a computer usable medium comprising instructions for performing “displaying simultaneously a plurality of alternate symbols from the first list in a pop-up menu at an insertion location for displaying at least one of the alternate symbols on a display of the hand-held device.” For independent claim 35 as amended, the combination of Griffin in view of Davis fails to disclose, teach or suggest at least the limitation of a means for “displaying simultaneously a plurality of alternate symbols from the first list in a

pop-up menu at an insertion location for displaying at least one of the alternate symbols on a display of the hand-held device.”

Figure 9 of Davis (See discussion at col. 15, lines 3-22) does not display a pop-up menu. It is a display screen of an application for developing a language-sensitive text searching system. As noted by the Examiner, Davis teaches a language-sensitive text searching system. The display shown is to assist a user in entering data to establish relationships between characters for the purpose of text searching. The display of Figure 9 does not disclose “displaying ... a pop-up menu at an insertion location for displaying at least one of the alternate symbols on a display of the hand-held device,” but simply illustrates a table for display on a workstation or personal computer screen (See Davis, col. 1, lines 29-31) illustrating text searching relationships, the displayed table having no relationship to an insertion location on a display for an alternate symbol.

Col. 15, lines 17-22 of Davis mention a pop-up menu (not shown in Davis) generated from clicking on the left-most column 900. A column is not a base symbol, so any pop-up menu resulting from the click is not displaying “alternate symbols associated with a first base symbol.”

One of ordinary skill in the art would not have been motivated to combine Griffin in view of Davis. It would not be practical, nor of assistance to a user of a hand-held device, to display a table illustrating text searching relationships between various characters when the user is trying to perform the different task of data entry which is assisted by “displaying simultaneously a plurality of alternate symbols from the first list [of alternate symbols associated with a first base symbol] in a pop-up menu at an insertion location for displaying at least one of the alternate symbols on a display of the hand-held device.”

The combination of Griffin and Davis fails to disclose, teach or suggest to one of ordinary skill in the art at least one of the recited limitations of independent claims 1, 13, 28 and 35 as amended. Therefore, claims 1, 13, 28 and 35 are patentably distinguished over the cited prior art of record.

Claim 8 depends from claim 1 so the arguments presented above for claim 1 apply to claim 8 to patentably distinguish claim 8 over the cited prior art including Griffin and Davis, either alone or in combination.

Claim 23 depends from claim 13 so the arguments presented above for claim 13 apply to claim 23 to patentably distinguish claim 23 over the cited prior art including Griffin and Davis, either alone or in combination..

Claim 25 depends from claim 13 so the arguments presented above for claim 13 apply to claim 25 to patentably distinguish claim 25 over the cited prior art including Griffin and Davis, either alone or in combination..

Claim 37 depends from claim 35 so the arguments presented above for claim 35 apply to claim 37 to patentably distinguish claim 37 over the cited prior art including Griffin and Davis, either alone or in combination..

The Examiner rejected original claims 2, 4, 5, 9, 10, 11, 17, 19-20, 24-26, 32, 36, 38, and 39 under 35 U.S.C. 103(a) as being unpatentable over Griffin in view of Laakkonen, US 6,043,760.

Claims 2, 4 and 5 depend from claim 1 so the arguments presented above for claim 1 apply to patentably distinguish claims 2, 4 and 5 over the cited prior art including Griffin, Davis or Laakkonen either alone or in combination.

Claims 9, 10 and 11 depend from claim 1 so the arguments presented above for claim 1 apply to patentably distinguish claims 9, 10 and 11 over the cited prior art including Griffin, Davis or Laakkonen either alone or in combination. Furthermore, claim 11 includes “wherein the first list of alternate symbols includes a symbol having an associational relationship with the base symbol wherein the associational relationship is that the symbol includes the base symbol” and this limitation further patentably distinguishes claim 11 over the cited prior art including Griffin, Davis or Laakkonen.

Claims 17, 19-20, and 24-26 depend from claim 13 so the arguments presented above for claim 13 apply to patentably distinguish claims 17, 19-20, and 24-26 over the cited prior art including Griffin, Davis or Laakkonen either alone or in combination. Furthermore, claim 26 further includes “wherein the first list of alternate symbols includes a symbol having an associational relationship with the base symbol wherein the associational relationship is that the symbol includes the base symbol” and this limitation further patentably distinguishes claim 16 over the cited prior art including Griffin, Davis or Laakkonen.

Claim 32 depends from claim 28 so the arguments presented above for claim 28 apply to patentably distinguish claim 32 over the cited prior art including Griffin and Laakkonen either alone or in combination.

Claims 36, 38, and 39 depend from claim 1 so the arguments presented above for claim 1 apply to patentably distinguish claims 36, 38, and 39 over the cited prior art including Griffin, Davis or Laakkonen either alone or in combination.

The Examiner rejected original claims 3, 12-13, 18, 27 and 30 under 35 U.S.C. 103(a) as being unpatentable over Griffin.

Claims 3 and 12 as amended depend from claim 1 so the arguments presented above for claim 1 apply to patentably distinguish claims 3 and 12 over the cited prior art including Griffin and Davis either alone or in combination.

The arguments presented above for claim 13 as amended apply to patentably distinguish claim 13 over the cited prior art including Griffin and Davis either alone or in combination.

Claims 18 and 27 as amended depend from claim 13 so the arguments presented above for claim 13 apply to patentably distinguish claims 18 and 27 over the cited prior art including Griffin and Davis either alone or in combination.

Claim 30 as amended depends from claim 28 so the arguments presented above for claim 28 apply to patentably distinguish claim 30 over the cited prior art including Griffin and Davis either alone or in combination.

New claim 42 depends from claim 1 so the arguments presented above for claim 1 apply to patentably distinguish claim 42 over the cited prior art including Griffin and Davis. Furthermore, claim 42 further includes “wherein the first list of alternate symbols includes an emoticon” and this limitation further patentably distinguishes claim 42 over the cited prior art including Griffin, Davis or Laakkonen.

New claim 43 depends from claim 13 so the arguments presented above for claim 13 apply to patentably distinguish claim 43 over the cited prior art including Griffin and Davis. Furthermore, claim 43 further includes "wherein the first list of alternate symbols includes an emoticon" and this limitation further patentably distinguishes claim 43 over the cited prior art including Griffin, Davis or Laakkonen.

Furthermore, Applicants submit that this application is now in condition for allowance of all of the pending claims 1-5, 8-13, 17-20, 23-32, 35-39, and 42-43 and therefore a prompt Notice of Allowance is respectfully requested.

Respectfully submitted,
JEFFREY C. HAWKINS *ET AL.*

Dated:

4/07/04

By: Eileen A. Lehmann

Eileen A. Lehmann, Reg. No.: 39,272

Fenwick & West LLP

801 California Street

Mountain View, CA 94041

Tel.: (650) 335-7246

Fax.: (650) 938-5200

21495/05943/DOCS/1405420.2